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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------------|---------------------|------------------|
| 09/750,483 | 12/28/2000 | Chio Arjona Alejandro Rafael | MX/JFC- 0018 | 5891 |

7590

09/22/2006

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| EXAMINER |
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SERGEANT, RABON A

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| ART UNIT | PAPER NUMBER |
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1711

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/750,483

Applicant(s)

RAFAEL ET AL.

Examiner

Rabon Sergent

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27, 29 and 32-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27, 29 and 32-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 8, 2006 has been entered.
2. Despite applicants' response to the Notice of Non-Compliant Amendment of June 1, 2006, applicants' amendment still fails to comply with the provisions of 37 CFR 1.121. All amendments to the specification and claims, including all additions and all deletions, however slight, must comply with 37 CFR 1.121 and must be clearly denoted by underlining, in the case of additions, and strikethrough, in the case of deletions, or double bracketing, in the case of deletions of five characters or fewer. The examiner has examined the instant amendment, as filed; however, all future amendments must fully comply with 37 CFR 1.121.
3. The amendment filed June 17, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amended formula for the polyglycolyl urea hydantoin resin within page 7 of the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Applicants' response has been considered; however, despite applicants' response, the amended structure is not representative of a polymer; therefore, it remains unclear how applicants' arguments or the originally filed structure and recited pathways lead to such a structure.

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4. Claims 27, 29, and 32-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The examiner has not found support for the claimed subject matter. The examiner has reviewed pages 4-7 of the specification and the original claims; however, support does not exist for the following limitations. With respect to step A)ii), the catalyst is added per Kg of product during a 3-5 hour period, not per Kg of reactants for an unspecified period. Applicants' response has not clearly addressed this issue. With respect to step B)vi), as aforementioned within paragraph 3, there is no support for the claimed structure. Support has not been found for the subject matter of claim 29; the specification only discloses a time of 19 hours; a range of up to 19 hours is not disclosed. Support has not been found for the subject matter of claim 33; the compound trethylenediamino octane has not been disclosed and does not exist. It is noted that the catalyst, triethylenediamine, is the same as the catalyst, 1,4-diazobicyclo[2,2,2] octane; in other words, the disclosure at page 6 of the disclosure appears to set forth only one catalyst species that is known by different names. With respect to claim 34, support has not been provided for the claimed temperature condition. With respect to claim 36, the specification does not disclose the claimed aromatic diglycinate, in that a compound corresponding to formula (II) has not been disclosed; the claimed structure does not correspond to any structure in the specification.

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5. Claims 27, 29, and 32-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to step A(iv) of claim 27, it remains unclear what is meant by "cooling the reaction solution at 20°C". Is this the temperature that is cooled to or is this the temperature that cooling begins at?

With respect to step A(iv) of claim 27, the language, "the drinking water" and "the bromine salt", lacks antecedent basis. Furthermore, it is unclear what meaningful limitation is conveyed by specifying that the water is drinking water. It is unclear how drinking water differs from water, in the context of the invention. Furthermore, applicants' step A(i) allows for the use of methylchloropropionate; therefore, in embodiments where this chloro-compound is utilized, it is unclear how the bromine salt is obtained.

The structure of formula I appears improper, because it does not denote a polymeric resin.

Within claim 33, the species, trethylenediamino octane, does not exist.

Within claim 36, the claimed formula II appears improper. For example, the valence of the first carbon atom is incorrect.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
September 15, 2006


RABON SERGENT
PRIMARY EXAMINER